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| APPLICATION NO.   | FILING DATE | FIRST NAMED INVENTOR | ATTORNEY DOCKET NO.  | CONFIRMATION NO. |
|---|-------------|----------------------|----------------------|------------------|
| 09/884,875  | 06/18/2001  | Lin-feng Chen        | UCAL-234             | 1891             |
| 24353   | 7590        | 01/28/2005           | EXAMINER             |                  |
| BOZICEVIC, FIELD & FRANCIS LLP<br>1900 UNIVERSITY AVENUE<br>SUITE 200<br>EAST PALO ALTO, CA 94303 |             |                      | LEFFERS JR, GERALD G |                  |
|   |             |                      | ART UNIT             | PAPER NUMBER     |
|   |             |                      | 1636                 |                  |

DATE MAILED: 01/28/2005

Please find below and/or attached an Office communication concerning this application or proceeding.

**Advisory Action**

|                           |              |
|---------------------------|--------------|
| Application No.           | Applicant(s) |
| 09/884,875                | CHEN ET AL.  |
| Examiner                  | Art Unit     |
| Gerald G Leffers Jr., PhD | 1636         |

--The MAILING DATE of this communication appears on the cover sheet with the correspondence address --

THE REPLY FILED 23 December 2004 FAILS TO PLACE THIS APPLICATION IN CONDITION FOR ALLOWANCE. Therefore, further action by the applicant is required to avoid abandonment of this application. A proper reply to a final rejection under 37 CFR 1.113 may only be either: (1) a timely filed amendment which places the application in condition for allowance; (2) a timely filed Notice of Appeal (with appeal fee); or (3) a timely filed Request for Continued Examination (RCE) in compliance with 37 CFR 1.114.

PERIOD FOR REPLY [check either a) or b)]

- a)  The period for reply expires 3 months from the mailing date of the final rejection.  
b)  The period for reply expires on: (1) the mailing date of this Advisory Action, or (2) the date set forth in the final rejection, whichever is later. In no event, however, will the statutory period for reply expire later than SIX MONTHS from the mailing date of the final rejection. See MPEP ONLY CHECK THIS BOX WHEN THE FIRST REPLY WAS FILED WITHIN TWO MONTHS OF THE FINAL REJECTION. See MPEP 706.07(f).

Extensions of time may be obtained under 37 CFR 1.136(a). The date on which the petition under 37 CFR 1.136(a) and the appropriate extension fee have been filed is the date for purposes of determining the period of extension and the corresponding amount of the fee. The appropriate extension fee under 37 CFR 1.17(a) is calculated from: (1) the expiration date of the shortened statutory period for reply originally set in the final Office action; or (2) as set forth in (b) above, if checked. Any reply received by the Office later than three months after the mailing date of the final rejection, even if timely filed, may reduce any earned patent term adjustment. See 37 CFR 1.704(b).

1.  A Notice of Appeal was filed on \_\_\_\_\_. Appellant's Brief must be filed within the period set forth in 37 CFR 1.192(a), or any extension thereof (37 CFR 1.191(d)), to avoid dismissal of the appeal.

2.  The proposed amendment(s) will not be entered because:

- (a)  they raise new issues that would require further consideration and/or search (see NOTE below);  
(b)  they raise the issue of new matter (see Note below);  
(c)  they are not deemed to place the application in better form for appeal by materially reducing or simplifying the issues for appeal; and/or  
(d)  they present additional claims without canceling a corresponding number of finally rejected claims.

NOTE: See Continuation Sheet.

3.  Applicant's reply has overcome the following rejection(s): \_\_\_\_\_.

4.  Newly proposed or amended claim(s) \_\_\_\_\_ would be allowable if submitted in a separate, timely filed amendment canceling the non-allowable claim(s).

5.  The a) affidavit, b) exhibit, or c) request for reconsideration has been considered but does NOT place the application in condition for allowance because: See Continuation Sheet.

6.  The affidavit or exhibit will NOT be considered because it is not directed SOLELY to issues which were newly raised by the Examiner in the final rejection.

7.  For purposes of Appeal, the proposed amendment(s) a) will not be entered or b) will be entered and an explanation of how the new or amended claims would be rejected is provided below or appended.

The status of the claim(s) is (or will be) as follows:

Claim(s) allowed: 1-10 and 19-31.

Claim(s) objected to: \_\_\_\_\_.

Claim(s) rejected: 32-42.

Claim(s) withdrawn from consideration: \_\_\_\_\_.

8.  The drawing correction filed on \_\_\_\_\_ is a) approved or b) disapproved by the Examiner.

9.  Note the attached Information Disclosure Statement(s)( PTO-1449) Paper No(s). \_\_\_\_\_.

10.  Other: \_\_\_\_\_

Gerald G Leffers Jr., PhD  
Primary Examiner  
Art Unit: 1636

***Advisory Action Attachment***

**Continuation of 2. NOTE:** The proposed amendment raises new issues in that it is not compliant with the rules for amending claims under 37 CFR 1.121. For example, claim 38 is not marked-up to demonstrate the changes made from the most recent set of claims that have been entered into the file (i.e. the claims of the 7/1/2004 amendment; e.g. see claim 38, lines 4-6) Further, the amendment of claim 38 to specifically recite "an anti-acetylated lysine antibody" changes the scope of the claims and requires a new search. It further raises new considerations concerning enablement in using an anti-acetylated lysine antibody in the recited cell-based methods when the antibody is likely to bind to many other acetylated proteins in the cell to which it is contacted (e.g. acetylated histones, etc.). The proposed amendment of claim 32 to recite "trichostatin A" also would require a new prior art search .

**Continuation of 5: Applicants' request for reconsideration. does NOT place the application in condition for allowance because:** Arguments directed to the proposed amendment are moot because the proposed amendment has not been entered.

If entered, applicants' proposed amendment of claim 38 would obviate the outstanding grounds of rejection over claims 38-42 for comprising impermissible New Matter. The proposed change would, however, raise new enablement considerations for the reasons outlined briefly above.

With regard to the new matter rejection of claims 32-37, applicants' proposed response would not overcome the rejection because there remains no support in the specification as originally filed for claiming the broadly recited method with regard to, for example, cell type,

detection method, etc., in order to identify literally any agent that can modulate NF- $\kappa$ B activity in transcription of a gene. The *only* place in the entire specification where applicants discussed a method for detecting deacetylated RelA in conjunction with blocking agents that block nuclear export was in a single working example that was not put forth as a broad method of identifying an agent that modulates NF- $\kappa$ B activity in transcription of a gene. This single working example was an experiment particularly designed to characterize normal regulation of NF- $\kappa$ B activity in the cell. This specific working example cannot be considered as providing support for broadly recited methods directed to identification of literally any agent (e.g. from literally any source), using literally any cell and literally any detection assay in the absence of any other evidence from the originally filed specification and claims that such broadly recited methods were part of applicants' invention. Amending the claim to recite the two specific blocking agents used in the working example (i.e. leptomycin B or trichostatin A) does not overcome this deficiency of the originally filed specification and claims.

### ***Conclusion***

Any inquiry concerning this communication or earlier communications from the examiner should be directed to Gerald G Leffers Jr., PhD whose telephone number is (571) 272-0772. The examiner can normally be reached on 9:30am-6:00pm.

If attempts to reach the examiner by telephone are unsuccessful, the examiner's supervisor, Remy Yucel can be reached on (571) 272-0781. The fax phone number for the organization where this application or proceeding is assigned is 703-872-9306.

Information regarding the status of an application may be obtained from the Patent Application Information Retrieval (PAIR) system. Status information for published applications may be obtained from either Private PAIR or Public PAIR. Status information for unpublished applications is available through Private PAIR only. For more information about the PAIR system, see <http://pair-direct.uspto.gov>. Should you have questions on access to the Private PAIR system, contact the Electronic Business Center (EBC) at 866-217-9197 (toll-free).

Gerald G Leffers Jr., PhD  
Primary Examiner  
Art Unit 1636

ggl



GERRY LEFFERS  
PRIMARY EXAMINER